

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 273021449 US, in an envelope addressed to: MS Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

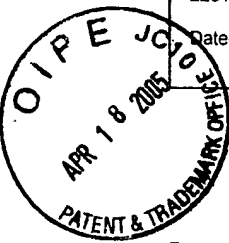
Dated: April 18, 2005

Signature: \_\_\_\_\_

(Diane Blevins)

Patent

Docket No. 532212000623



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Thomas L. CANTOR

Serial No.: 10/617,489

Filing Date: July 10, 2003

For: METHODS, KITS AND ANTIBODIES  
FOR DETECTING PARATHYROID  
HORMONE

Examiner: J. Cheu

Group Art Unit: 1641

**SUPPLEMENTAL INFORMATION DISCLOSURE  
STATEMENT UNDER MPEP 724.02**

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.56 and MPEP 724.02, the attention of the Patent and Trademark Office is hereby directed to the **SUBJECT TO PROTECTIVE ORDER** documents and the **PROPRIETARY** document listed on the attached Form PTO/SB/08a/b. It is respectfully requested that the information be expressly considered during the prosecution of this application.

The document numbers 1, 2, and 3 listed on the attached Form PTO/SB/08a/b are **SUBJECT TO PROTECTIVE ORDER** and should only be viewed by the Examiner or other authorized Patent and Trademark Office Employees. These three documents are from civil action number 02 CV 0046 B (JMA), Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical

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Laboratory, Inc. and Scantibodies Laboratory, Inc., currently pending in the United States District Court for the Southern District of California.

Document number 4 listed on the attached Form PTO/SB/08a/b is **PROPRIETARY** in nature and should only be viewed by the Examiner or other authorized Patent and Trademark Office Employees.

A copy of each document that is **SUBJECT TO PROTECTIVE ORDER** and the **PROPRIETARY** document listed on the attached Form PTO/SB/08a/b are each enclosed in a sealed, clearly labeled envelope.

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☐ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☒ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
  - ☐ A fee is required. A check in the amount of \_\_ is enclosed.
  - ☒ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly; no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of \_\_ is enclosed.

☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17 is attached to this submission in duplicate.)

Pursuant to MPEP § 2004.13, Applicant points out that Nichols Institute Diagnostics Inc. (Nichols) has sued the assignee of the present application, Scantibodies Laboratory, Inc. (Scantibodies) for alleged infringement of U.S. Patent No. 6,030,790 ('790 patent) (*See* Exhibit A of document No. 1.) The '790 patent was submitted and considered by the Examiner in the prosecution of the parent patents of the present application, U.S. Patent No. 6,689,566 B1 (the '566 patent) and U.S. Patent No. 6,743,590 B1. The '790 patent was also submitted in the February 25, 2004 IDS (Reference No. 11) and considered by the Examiner in connection with the present application (*See* the January 24, 2005 Office Action). Applicant wishes to bring the Examiner's attention to Exhibit M of document No. 3, "Claim Chart for U.S. Patent No. 6,030,790" submitted by Nichols, in which the '566 patent is discussed.

Applicant would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.


The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

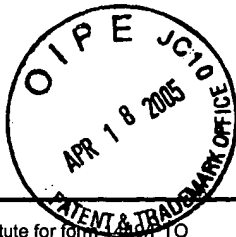
In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicant petitions for any required relief including

extensions of time and authorizes the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 532212000623.

Dated: April 16, 2005

Respectfully submitted,

By   
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ALTERNATIVE TO PTO/SB/08a/b (06-03)

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  (Use as many sheets as necessary)				<b>Complete if Known</b>	
				Application Number	10/617,489
				Filing Date	July 10, 2003
				First Named Inventor	Thomas L. CANTOR
				Art Unit	1641
Sheet	1	of	1	Examiner Name	J. Cheu
				Attorney Docket Number	532212000623

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. <sup>1</sup>	Document Number Number-Kind Code <sup>2</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document Country Code <sup>3</sup> -Number <sup>4</sup> -Kind Code <sup>5</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>

\*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS – SUBJECT TO PROTECTIVE ORDER			
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
	1.	Declaration of Julia A. Miller in Support of Nichols Institute Diagnostics, Inc.'s Motion for Leave to File Amended Complaint, filed January 26, 2004	
	2.	Nichols Institute Diagnostics, Inc.'s Notice of Lodgement of Corrected Copy of Proposed Second Amended Complaint, Exhibit A to Declaration of Julia A. Miller in Support of Nichols' January 26, 2004 Motion for Leave to File Amended Complaint, filed February 23, 2004	
	3.	Declaration of Julia A. Miller in Support of Nichols Institute Diagnostics, Inc.'s Motion for Summary Judgment that the '790 Patent Claims are Valid and Infringed, filed February 28, 2005	

NON PATENT LITERATURE DOCUMENTS – PROPRIETARY INFORMATION			
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
	4.	Declaration of Thomas L. Cantor with Exhibit A, executed on April 7, 2005	

\*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature		Date Considered	
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